

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 7 of 17

### REMARKS

In response to the Non-Final Office Action mailed **October 24, 2008** (hereinafter "Office Action"), no claims have been cancelled, amended, or newly added. Therefore, claims 47-51, 53-55, 57, 59, 61, and 62 remain pending. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

### REJECTIONS UNDER 35 U.S.C. § 112, ¶1

Claims 47-51, 53-55, 57, and 59 stand rejected under 35 U.S.C. § 112, ¶1, as *allegedly* containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention [Office Action, pg. 1]. Applicants traverse this rejection because, as demonstrated below, the claim recitations identified by the Examiner in independent claims 47 and 57 are fully supported by the as-filed Specification.

#### A. Preliminary Comment

In the Decision on Appeal (Appeal No. 2007-0794) of the Board of Patent Appeals and Interferences (hereinafter "Board"), mailed August 7, 2008 (hereinafter "Decision"), the rejection of dependent claim 56 under 35 U.S.C. § 103(a) was reversed [Decision, pg. 30, lines 12-14; and pg. 38, lines 4-6], as was the rejection of dependent claim 60 under 35 U.S.C. § 103(a) [Decision, pg. 31, lines 9-12; and pg. 38, lines 4-6].

Despite the fact that dependent claims 56 and 60 were each first introduced in the Preliminary Amendment filed with the above-referenced application on June 12, 2001, neither dependent claim 56 nor dependent claim 60 were ever rejected under 35 U.S.C. § 112, ¶1 at any time during prosecution. Rather, only after independent claims 47 and 57 were amended to recite the features previously present in dependent claims 56 and 60, respectively [see 10-07-08 Amendment], did the Examiner raise a rejection under 35 U.S.C. § 112, ¶1 with regard to these particular claim recitations. The introduction of new claim rejections - post-Appeal - that could have been raised at *any* time during prosecution is a

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 8 of 17

clear example of piecemeal examination [see MPEP § 707.07(g)], which has resulted in unnecessary delay and expense for Applicants. Nonetheless, the rejections of independent claims 47 and 57 are addressed below.

B. Independent Claim 47

With regard to independent claim 47, the Examiner alleges that there is no support in the as-filed Specification for the recitation of "*wherein said electronic coupon includes data representative of the identity of a location at which additional coupon information resides.*" Applicants traverse this rejection because the Specification clearly supports the foregoing claim recitation.

For instance, in one non-limiting example, Applicants' Specification discloses that coupons, which may be printed and/or electronically redeemed [Specification, *e.g.*, pg. 26, line 20 – pg. 27, line 3], are encoded with user-specific information such as, for example, a user's online identification number [Specification, *e.g.*, pg. 25, lines 15-27]. The remote personal computer (6) [FIG. 1] used by the user to access the online service includes coupon information residing in a coupon database file (30) and/or an offline coupon data management routine file (32) [Specification, *e.g.*, pg. 20, lines 16-20; pg. 20, line 24 – pg. 21, line 27; and FIGS. 1-2].

Accordingly, the rejection of independent claim 47 (and dependent claims 48-51 and 53-55) under 35 U.S.C. § 112, ¶1 is legally improper and should be withdrawn.

C. Independent Claim 57

With regard to independent claim 57, the Examiner alleges that "only minimal support" can be found in the as-filed Specification for the recitation of "*establishing a connection between said subsequent server and an authentication server, said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon.*" Applicants traverse this rejection because the Specification clearly supports the foregoing claim recitation.

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 9 of 17

For instance, in one non-limiting example, Applicants' Specification discloses that coupon redemption center (12) and/or database (13) [*e.g.*, FIG. 1] may, for example, monitor coupon redemption and disallow fraudulent redemption [Specification, *e.g.*, pg. 12, line 28 – pg. 13, line 2; pg. 30, lines 20-28; and FIG. 1].

Additionally, with regard to the Examiner's allegation that certain words do not exist in Applicants' Specification, it should be noted that, to satisfy the written description requirement, it is not necessary for the claimed subject matter to be described in *haec verba* in the specification. *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922-923, 69 U.S.P.Q. 2d (BNA) 1886, 1892 (Fed. Cir. 2004). Rather, "the written description requirement can be satisfied by 'words, structures, figures, diagrams, formulas, etc.'" *Koto Manufacturing Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154, 72 U.S.P.Q. 2d (BNA) 1190, 1199 (Fed. Cir. 2004) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q. 2d (BNA) 1961, 1966 (Fed. Cir. 1997)).

Accordingly, the rejection of independent claim 57 (and dependent claim 59) under 35 U.S.C. § 112, ¶1 is legally improper and should be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 47-51, 53-55, 57, 59, 61, and 62 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,882,675 to Nichtberger *et al.* (hereinafter "Nichtberger") in view of U.S. Patent No. 5,380,991 to Valencia *et al.* (hereinafter "Valencia") [Office Action, pg. 2]. Applicants traverse the rejection under 35 U.S.C. § 103(a) for the reasons set forth below.

##### **A. Preliminary Comment Regarding Independent Claims 47 and 57**

By way of background, in the 10-07-08 Amendment, independent claim 47 was amended to recite the features previously present in dependent claim 56 since the previous rejection of dependent claim 56 under 35 U.S.C. § 103(a) in view of the alleged Nichtberger/Valencia combination was *reversed* by the Board [*see* Decision, pg. 30, lines 12-14; and pg. 38, lines 4-6]. Independent claim 57 was also amended to recite the features

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 10 of 17

previously present in dependent claim 60 since the previous rejection of dependent claim 60 under 35 U.S.C. § 103(a) in view of the alleged Nichtberger/Valencia combination was *reversed* by the Board [Decision, pg. 31, lines 9-12; and pg. 38, lines 4-6].

Although MPEP § 1214.06 (II) would have required the Examiner to take similar action, Applicants submitted the 10-07-08 amendment (along with a Request for Continued Examination to guarantee entry) in an effort to expedite<sup>1</sup> prosecution by placing the application in condition for allowance.

The Examiner, however, has disregarded the finding of the Board and is now maintaining the same rejection with *new* citations from the *same* Nichtberger/Valencia combination:

Examiner has found new citations, not presented to the BPAI before, from the same Nichtberger and Valencia reference that are relevant to these two features (which were added to claims 47 and 57). Hence, the same rejection has been utilized with the addition of citations to better address these two features.

[Office Action, pg. 9].

By undertaking the exercise of seeking out new citations in the disclosures of Nichtberger and Valencia, the Examiner is acting contrary to MPEP § 1214.06 (II), again resulting in unnecessary delay and expense for Applicants. Although Applicants view this exercise as being improper, and reserve the right to further challenge the propriety of the new rejections, the rejections of independent claims 47 and 57 under 35 U.S.C. § 103(a) are addressed below.

B. Independent Claim 47

For the claim recitation (previously presented in dependent claim 56) reciting that the "*...electronic coupon includes data representative of the identity of a location at which*

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<sup>1</sup> Applicants were further proactive in filing the 10-07-08 Amendment because they have waited over one year (and are still waiting) for the Office to follow proper procedure following a decision by the Federal Circuit [MPEP § 1216.01(I)(B)] in related Application Serial No. 09/321,597, pending before the same Examiner.

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 11 of 17

*additional coupon information resides,"* the Examiner now relies on col. 28, lines 15-30 of Nichtberger. The relied-upon passage recites:

A "zoom" feature may be provided whereby, by touching a particular area on a first display screen, the customer causes that display to enlarge, or a set of additional related displays to appear. For example, if the first screen listed numerous categories of items, with pets as one category, ***touching the "pets" area on the screen may cause a series of pet coupons to be displayed.*** This would allow the inclusion of hundreds of coupons on the kiosk, without forcing the customer to stand at the kiosk for many minutes to review all available selections. ***Another application of this feature may be to display recipes when a certain coupon is chosen, and then to show the location or nutritional value of a particular item in the recipe when that item is touched.***

[Nichtberger, col. 28, lines 15-30].

The foregoing passage appears to disclose that an "area" of a display screen may be touched to cause a series of related coupons to be displayed, and that recipes may be displayed when a certain coupon is chosen. There is no disclosure in this relied-upon passage, however, that the *displayed* coupon includes data representative of the *identity of a location at which additional coupon information resides*. Contrary to the Examiner's assertion, the coupon does not link to nutritional or recipe information. Rather, the location or nutritional value of *a particular item* in a recipe may be shown when *that item* is touched.

For at least the foregoing reason, the Examiner has failed to establish that the alleged combination of Nichtberger and Valencia teaches each of the features of independent claim 47. As such, the Examiner has failed to establish a *prima facie* case of obviousness, and the rejection of independent claim 47 under 35 U.S.C. § 103(a) is improper and should be withdrawn. Dependent claims 48-51 and 53-55 are allowable at least by virtue of their dependency from independent claim 47.

C. Independent Claim 57

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 12 of 17

Independent claim 57 recites the following claim feature (previously presented in dependent claim 60):

establishing a connection between said subsequent server and an authentication server, said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon;

In the Office Action, the Examiner concedes that Nichtberger fails to disclose the foregoing claim feature. In an attempt to cure this acknowledged deficiency of Nichtberger, the Examiner now relies on the alleged teachings of Valencia:

Nichtberger does not explicitly disclose that the authorizing of the coupon at time of coupon use occurs by a central server system or server system that is remote from the terminal server system.

However, Valencia discloses the authorizing of the coupon occurs by a second server system or server system that is remote from the store server system at time of coupon use (7:50-8:15; 9:40-50). Note that Valencia discloses that the terminal server and/or central computer server can authorize the coupon at time of use.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's central server coupon authorization to Nichtberger's terminal coupon authorization and central server. These features of the claimed invention are merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

[Office Action, pgs. 5-6].

The rejection of independent claim 57 under § 103 is improper for at least the reason that the Examiner has failed to provide a viable, rational underpinning to support the articulated reason for modifying Nichtberger in the manner alleged.

Nichtberger, for example, discloses that, after a customer selects the coupons he or she wishes to redeem, the CDR unit (20) records the selection and makes information

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 13 of 17

identifying the customer and selected coupons available to each of the checkout stations which comprise the checkout system (18) of the supermarket [Nichtberger, *e.g.*, col. 5, lines 1-16]. Nichtberger further recites:

After the user has made his or her purchases, he or she goes to one of the checkout stations and presents his or her card to the attendant at the station. The attendant causes the card to be read by a suitable card reader (such as a UPC card scanner) and the checkout system 18 then automatically credits the customer for the coupons the customer has selected where there are corresponding purchases against which the coupons are to be applied.

Thereafter, information regarding the redeemed coupons is transmitted to the central processing unit 16 which then automatically debits the manufacturer who distributed the coupons and credits the supermarket corresponding to the local station 10 at which the coupon was redeemed.

***Hence, in the preferred embodiment, selection (distribution), redemption and clearing are accomplished automatically without handling of paper coupons by customer or store and thus without the possibility of the types of fraud which now plague the industry.***

[Nichtberger, col. 5, lines 17-36, *emphasis added*].

It is not clear to Applicants, nor has the Examiner established, why it would have been obvious to modify the system of Nichtberger -- wherein fraud is apparently already avoided due, in part, to the communication between the local CDR unit (20) and the checkout system (18) within a local store (10) -- by introducing an *additional* server into the system.

To avoid a finding of obviousness due to the luxury of hindsight, there must be an explicitly articulated reasoning with a rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 127 S.Ct. 1727, 1741, 82 USPQ 2d 1385, 1396 (2007).

In this instance, the Examiner's motivation constitutes a conclusory statement alleged without any evidentiary support, and appears to comprise mere speculation. If a

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 14 of 17

rejection under § 103 is merely an unsupported assertion or mere speculation, the burden does not shift to the applicant, but rather remains on the Patent Office Examiner. *See In re Donaldson*, 16 F.3d 1189, 1197, 29 USPQ 2d 1845, 1852 (Fed. Cir. 1994).

In the absence of any viable, rational underpinning to support the articulated reason for modifying Nichtberger in the manner alleged, it is clear that the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness. The rejection of independent claim 57 under § 103 is therefore improper, and should be withdrawn.

Assuming arguendo that it were deemed legally proper to modify Nichtberger to include the alleged teachings of Valencia in the manner alleged by the Examiner (which Applicants do not concede), the references, even if combined, still fail to disclose, teach, or suggest all of the claim features. In particular, the portions of Valencia cited by the Examiner do not appear to teach "establishing a connection between said subsequent server and an authentication server, said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon."

The relied-upon portions of Valencia, for example, recite:

Once the customer chooses his or her appropriate items, they are scanned by the scanner 60, which is in communication with the in-store central computer, to obtain the appropriate pricing information. Once obtained, this information is sent to the master reader/writer 62 which is provided at each cashier's checkout station. Once all of the items have been scanned and totaled, the card 2 is inserted into the master reader/writer 62. The specific act of inserting the card therein would allow the master reader/writer 62 to perform a series of tests with the card, one of which relates to the search of progressive coupon information residing in the card. Having found, or not found, this information in the card, this information is also sent to the in-store central computer system 70. Residing in this system 70 is all of the information relating to a specific coupon value issued by the manufacturer, arranged to match the number sequence for each product in order to search and differentiate between items. As it pertains to progressive coupon items, the computer system 70 will search and match the appropriate coupon value according to the flag position noted on the



Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 15 of 17

customer's card 2. The in-store central computer system 70 will then add the progressive coupon values to the value of all other coupon discounts applicable to the total customer purchase. The total savings value and updated flag tracking information is sent back to the master reader/writer 62 and is recorded on the customer's smart card 2. It should be noted that, although the system of the present invention employs a centralized in-store computer system 70, all of the functions of the system 70 can be performed at terminals 62, 64 and 66. This is important, since the system would still operate even if the central in-store computer system fails.

[Valencia, col. 7, line 50 – col. 8, line 15].

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As a customer in possession of the smart card 2 approaches the checkout counter of any participating store, the smart card 2 would be inserted into the proper reader/writer provided at the register. This reader/writer alone, or in combination with the store's main computer, would conduct a series of tests on the smart card as previously described. Additionally, the memory of the smart card 2 will have a section dedicated to accumulating individual running balances attributed to particular manufacturers or retailers who offer discount coupons. This is made possible because of the uniqueness of bar codes and because of integrating unique identification numbers as they relate to specific manufacturers and retailers participating in the system.

[Valencia, col. 9, lines 40-50].

Col. 7, line 50 – col. 8, line 15 of Valencia does not appear to disclose authentication, but rather appears to disclose a process for searching and matching appropriate coupon values in an in-store central computer system (70). Col. 9, lines 40-50 of Valencia appear to disclose the functionality of accumulating (in the memory of the smart card) individual running balances attributed to particular manufacturers or retailers who offer discount coupons. Neither passage, however, appears to teach authentication of a coupon.

For at least the foregoing reasons, neither Nichtberger nor Valencia, either alone or in combination, disclose, teach, or suggest each of the features of independent claim 57. As such, the Examiner has failed to establish a *prima facie* case of obviousness, and the

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 16 of 17

rejection of independent claim 57 under 35 U.S.C. § 103(a) is improper and should be withdrawn. Dependent claim 59 is allowable at least by virtue of its dependency from independent claim 57.

D. Independent Claims 61 and 62

In the Decision, the Board reversed the rejection of independent claims 61 and 62 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn in view of U.S. Patent No. 5,734,823 to Saigh *et al.* ("Saigh") [see Decision, pg. 37, lines 8-9; and pg. 38, lines 7-9]. No other grounds of rejection were presented for independent claims 61 and 62.

Now, for the first time during prosecution, the Examiner has rejected independent claims 61 and 62 under 35 U.S.C. §103(a) as allegedly being unpatentable over the alleged combination of Nichtberger and Valencia. Applicants view this new rejection as being improper [contrary to MPEP § 1214.06 (II)], and reserve the right to further challenge the propriety of this new rejection. Nonetheless, the rejection of independent claims 61 and 62 under 35 U.S.C. § 103(a) is improper because the Examiner has failed to establish a *prima facie* case of obviousness.

In particular, assuming arguendo that it were deemed legally proper to modify Nichtberger to include the alleged teachings of Valencia in the manner alleged by the Examiner (which Applicants do not concede), the references, even if combined, still fail to disclose, teach, or suggest all of the claim features. For example, neither the customer's special card of Nichtberger nor the smart card of Valencia constitute "remote client systems" as the term is known and understood by those having ordinary skill in the art, and as recited in each of independent claims 61 and 62.

For at least the foregoing reasons, neither Nichtberger nor Valencia, either alone or in combination, disclose, teach, or suggest each of the features of independent claims 61 and 62. As such, the Examiner has failed to establish a *prima facie* case of obviousness, and the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Applicant: BARNETT *et al.*  
Serial No: 09/879,825  
Filing Date: June 12, 2001  
Page: 17 of 17

**CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

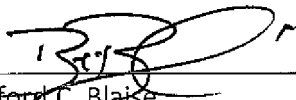
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: April 24, 2009

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